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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/774,066	02/07/2004	Veronica Cook-Euell	U-1	4828

21324 7590 01/25/2007
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EXAMINER

MOHANDESI, JILA M

ART UNIT	PAPER NUMBER
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3728

SHORTENED STATUTORY PERIOD OF RESPONSE	NOTIFICATION DATE	DELIVERY MODE
3 MONTHS	01/25/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Notice of this Office communication was sent electronically on the above-indicated "Notification Date" and has a shortened statutory period for reply of 3 MONTHS from 01/25/2007.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patents@hahnlaw.com
akron-docket@hotmail.com

Office Action Summary

Application No.

10/774,066

Applicant(s)

COOK-EUELL, VERONICA

Examiner

Jila M. Mohandesi

Art Unit

3728

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on RCE filed 11/15/06.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3 and 4 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/15/06 has been entered.
2. The Affidavit under 37 C.F.R. 1.131 filed on 11/15/06 under 37 CFR 1.131 is sufficient to overcome the Hennessy et al. (US pub. No. 2005/0151321) reference.

Claim Rejections - 35 USC § 102 or § 103

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

Art Unit: 3728

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1 and 3-4 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Bathum et al. (US 7,055,265).

Bathum discloses a method of constructing an inventory of a plurality of insole-shape shoe inserts (see Figure 1 embodiment); allocating said inventory into a plurality of categories (running, hiking, walking, water activities); assigning a message to the insert (see Figure 14 embodiment); instructing the user to select one or more of the shoe inserts for placement within associated shoe; and instructing the user to stack the one or more inserts on top of each other. See Figures 1-16 and column 6, lines 8-37. This printed material is broadly considered motivational, inspirational and/or educational.

Printed Matter Not Patentable

The only difference between Bathum inventory of plurality of insoles with messages, and the claimed spiritual message recited in Applicant's claims 1 and 3-4, **resides in the meaning and information conveyed by printed matter. Such differences are considered unpatentable, *Ex parte Breslow*, 192 USPQ 431.**

Furthermore or in the alternative, Bathum inventory of plurality of insoles with messages disclose the claimed invention except for the spiritual messages, set forth in the Applicant's claims 1 and 3-. It would have been obvious to one having ordinary skill in the art at the time Bathum's invention was made to include other printed material (e.g. spiritual messages and truths, etc.) to Bathum's insoles/inserts since it would only

depend on the **intended use** of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate (insole/insert surface), it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack*, 217 USPQ 401, (CAFC 1983). The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a specific type of insole/insert does not alter the functional relationship. **Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability.** Thus, there is no novel or unobvious functional relationship between the claimed printed matter (e.g. spiritual message or truth, etc. recited in Applicant's claims 1 and 3-4) and the substrate (e.g. insole/insert surface), which is required for patentability.

6. Claims 1 and 3-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bathum et al. (US 7,055,265) in view of Galm (US 5,884,770). Bathum discloses a method of constructing an inventory of a plurality of insole-shape shoe inserts (see Figure 1 embodiment); allocating said inventory into a plurality of categories (running, hiking, walking, water activities); assigning a message to the insert (see Figure 14 embodiment); instructing the user to select one or more of the shoe inserts for placement within associated shoe; and instructing the user to stack the one or more inserts on top of each other. See Figures 1-16 and column 6, lines 8-37. Bathum does not appear to disclose the message being a spiritual message and for each of the insert to have a different message provided thereon. Galm discloses that messages can be in

Art Unit: 3728

the form of spiritual message and discloses constructing an inventory of thin articles depicting a substantially different spiritual message on each of the thin articles. The message on the thin articles can be drawings or photographs of a person, place or a thing. The message on each thin article is written and/or organized in a manner not only to motivate, inspire, or educate, but also to influence or persuade the person viewing the information to act on the message, i.e., to adopt a personal behavior consistent with the message. See column 5, lines 26-41. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a different spiritual message on each of the inserts of Bathum as taught by Glam to motivate, inspire, and educate the person reading the message.

Response to Arguments

7. Applicant's arguments with respect to claims 1 and 3-4 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jila M. Mohandesi whose telephone number is (571) 272-4558. The examiner can normally be reached on Monday-Friday 7:30-4:00 (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (571) 272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Jila M Mohandesi
Primary Examiner
Art Unit 3728

JMM
January 11, 2007